

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 9-14 and 26-30 are pending in the application. Of these claims 9-11 are directed to elected subject matter while the remaining claims stand withdrawn as directed to non-elected subject matter. They remain in the application until such time as the patentability of claims 9-11 is determined at which point applicants may request rejoinder of the withdrawn claims, as explained in the response of December 20, 2005.

Response to Rejection under 35 U.S.C. §112, ¶1

Responsive to point 2 of the Official Action, claim 9 is amended to specify that the optically active polyester derivative is either in the 2,S, 3,R or 2,R, 3,S configuration. This is consistent with the description of the invention including that on pages 16-17 as well as the working examples. This Amendment serves to focus the claims and further distinguish them from the cited and applied prior art.

In the Official Action the examiner comments in the paragraph bridging pages 2 and 3 “(there are) no examples of (2S,3S), (2R,3S) or (2R,3R) forms of the optically active epoxyester derivatives of formula (3)...disclosed.” While this may be correct as to working examples, the disclosure and enablement of the description of the invention is not limited to the working examples provided. Applicants do address this point with respect to the (2R,3S) form in the paragraph on page 41, lines 6-11 where they state:

Further, in the present invention, by replacing (R)-1,1'-bi-2-naphthol, it will be possible to prepare a (2R,3S) form which is optically symmetrical to the compound of the present invention.”

Thus applicants have already addressed this point with fully enabling disclosure and the description of the invention is not “limited to those (stereoisomers) found on pages 16-17” as the Examiner contends at the top of page 3 of the Action.

Response to Prior Art-Based Rejections

Claims 9-11 are rejected as allegedly being anticipated by the Corey et al *Tetrahedron Letters* publication for the reasons expressed on page 3 of the Official Action. This rejection is not believed to be pertinent to the claims as above amended.

The Corey et al reference discloses synthesis of an epoxy compound or its derivative via an α -bromo- β -hydroxy intermediate as a different method. With respect to the α -bromo- β -hydroxy intermediate, one in which R₁ is a cyclohexyl group is disclosed, but there is no disclosure of an epoxy compound assumed to be derived from it. The one actually disclosed as derived, is an epoxy compound where R₁ is a Ph group only. Thus, it cannot be assumed nor is it disclosed that a compound in which R₁ is a cyclohexyl group can be produced by the method employing tBuOK as disclosed in the reference. Further, the R₂ group disclosed is a tBu group only – there is no disclosure of the Ph group.

Reconsideration and withdrawal of the anticipation rejection is requested.

The same claims are also rejected as allegedly being obvious over three articles in *Tetrahedron Letters*, the first to Baures et al and the second two to Corey et al one of which is discussed above. The Baures et al reference discloses the R₁ group being a Ph group or a substituted Ph group only – there is no disclosure of a cyclohexyl group.

Although the Official Action includes a rather detailed justification for combining the disclosures of the three references, the basic result seems to be that the combination is driven by either conjecture or a hindsight reconstruction of the prior art. The Official Action assumes various motivations but lacks any clear teaching such motivations may have or would be encountered, hence the rejection is flawed. Reconsideration and withdrawal of this rejection is requested.

Response to Nonstatutory Obviousness-type Double Patenting Rejection

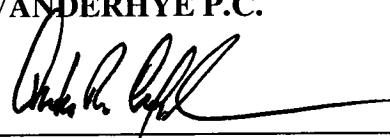
Claims 9 and 11 are rejected on the grounds of non-statutory obviousness-type double patenting over claims 1 and 2 of U.S. patent 6,787,657 to Tanaka, commonly assigned to the owners of the present application. Response to this rejection is held in abeyance until such time as allowable subject matter is indicated in this application and the final form of allowable claims is reached.

Reconsideration and favorable action are solicited. Should the examiner require further information please contact the undersigned.

Respectfully submitted,

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